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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,699	04/28/2006	Shinichiro Kadowaki	96790P533	3744

8791 7590 12/09/2009  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
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SUNNYVALE, CA 94085-4040

EXAMINER
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HAUTH, GALEN H

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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12/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,699	<b>Applicant(s)</b> KADOWAKI ET AL.	
	<b>Examiner</b> GALEN HAUTH	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☒ Claim(s) 28 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. Acknowledgment is made to applicant's amendment of claim 28 and the introduction of claim 30. No new matter has been added. The rejection of claim 28 under 35 USC 112 is withdrawn.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orlosky (PN 4693446) in view of Kitahara (JP 58-224724).

a. With regards to claim 29, Orlosky teaches a method for forming a lens by providing two lens forming molds in a cylindrical gasket and filling a lens material between the two molds and curing it (abstract). As seen in Figures 1, 2, and 4 Orlosky teaches a elastic projecting band which integrally projects on an

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inner circumferential wall throughout the entire circumference including a proximal end portion projecting from the inner circumference and a tapered distal end portion closer to an axial direction of the gasket main body than the end portion. Orlosky teaches that the lens molds used have a diameter greater than the inner diameter of the gasket (col 5 ln 29-31, a larger diameter than the gasket requires elastic deformation pressure to be applied from the gasket onto the mold due a lack of tolerance between the inner diameter of the gasket and the outer mold diameter.) Orlosky does not teach that when the mold is held, the tapered surface comes into strongest contact with the lens molding surface side circumferential edge of the mold.

b. Kitahara teaches a method for molding lens with a gasket in which a dovetail lens type can be formed through the use of a gasket internal shape (abstract) defined in Fig. 10. As shown in Figure 10, the internal surface of the gasket is tapered toward the open ends of the molds and comes into strongest contact with the lens forming side circumferential edge of each mold. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the internal gasket shape of Kitahara for the gasket of Orlosky, because both relate to lens formation though gasket molding presenting a reasonable expectation of success, and doing so allows for the formation of desired dovetail shaped lenses.

***Claim Objections***

5. Claims 28 and 30 are objected to because of the following informalities: Claims 28 and 30 recite that the proximal end portion flexes “more largely” than the distal portion which should read the proximal end portion flexes “more” than the distal portion. Additionally, Claims 28 and 30 use the phrase “by virtue of the fact that” which should be replaced by the phrase “while” to clearly define a positive limitation. Appropriate correction is required.

***Allowable Subject Matter***

6. Claims 28 and 30 would be allowable if amended to overcome the objections cited above. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor render obvious a method of using a lens molding gasket in which a projection band around a circumference of the inside of the gasket includes a ring like proximal end portion which projects from the inner circumference wall to extend in a direction substantially perpendicular to an axial direction of the gasket main body, a tapered distal end portion which extends in a direction substantially parallel to the axial direction of the gasket main body, and a bent portion connecting them in which when holding the mold, bringing a vertex of the distal end portion into linear contact with the lens forming surface of said one mold while the distal end portion undergoes a smaller flexure in a direction perpendicular to the axial direction of the gasket main body than a flexure undergone by the proximal end portion in the axial direction of the gasket main body as well as the other limitations recited in the claims.

***Response to Arguments***

7. Applicant's arguments with respect to claim 29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GALEN HAUTH whose telephone number is (571)270-5516. The examiner can normally be reached on Monday to Thursday 8:30am-5:00pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571)272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/GHH/

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791